REMARKS

Upon entry of the foregoing amendment, Claims 1-11 and 13-20 will remain pending in the application. Claims 1, 11, 13, 14 and 15 have been amended. The amendments are supported by the specification in paragraphs [0075]-[0082], Figure 5, and original claim 14. These changes do not introduce new matter, and their entry is respectfully requested.

In the Office Action of August 20, 2008, the Examiner set forth a number of grounds for rejection. These grounds are addressed individually and in detail below.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-7, 11-15 and 18-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0083741 to Chang (hereinafter "Chang") for the reasons set forth on pages 4-12 of the Office Action. Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic Research & Foundation v. Genentech Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Independent Claim 1 of the present application, as amended, is directed to a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled to a host computer having an operation system with an AutoRun mechanism, comprising: 1) the operation system of the host computer sending out an inquiry command to the semiconductor

storage device for detecting a type of the device; 2) the semiconductor storage device replying to the inquiry command from the operation system based on one or more predetermined device types; 3) the operation system of the host computer deeming the semiconductor storage device as one type of the predetermined device types according to the reply from the semiconductor storage device, and performing an operation accordingly; and 4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates said deemed device type so that a specific file directed by the searched AutoRun configuration file can be executed by the operation system, wherein an AutoRun program is preset in the semiconductor storage device coupled to the host computer and capable of directing the specific file; and the AutoRun program is directed by the AutoRun configuration file, wherein the searching step comprises: the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value; executing the AutoRun program to search for the specific file, copying the AutoRun program and the specific file to be executed to a host disk of the host computer; the copy of the AutoRun program in the host disk of the host computer calling and executing the copy of the specific file; and the timing program sending out a reset command to the semiconductor storage device when time arrives at the predetermined timing value.

Independent Claim 11 of the present application, as amended, recites a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled with a host computer having an operation system with an AutoRun mechanism, comprising: 1) the operation system of the host computer sending out a first inquiry command to the semiconductor storage device for detecting the type of the device; 2) the semiconductor storage

device replying to the first inquiry command from the operation system that the device is an optical disk drive; 3) the operation system of the host computer deeming the semiconductor storage device as an optical disk based on the reply from the semiconductor storage device, and performing an operation accordingly; and 4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates an optical disk drive so that a specific file directed by the AutoRun configuration file can be executed, the searching step comprising: (4-1) the operation system sending out a second inquiry command to detect whether an optical disk is inserted into the optical disk drive when the semiconductor storage device is deemed to be an optical disk drive; (4-2) in response to the second inquiry command, the semiconductor storage device, which simulates an optical disk drive, replying to the operation system after a predetermined delay, that an optical disk is already inserted into the optical disk drive so that the operation system can deem the semiconductor storage device as an optical disk drive with an optical disk; and (4-3) the AutoRun mechanism of the operation system searching for the AutoRun configuration file stored in the semiconductor storage device which simulates the optical disk drive with an optical disk so that the operation system can execute the specific file directed by the AutoRun configuration file, wherein an AutoRun program is preset in the semiconductor storage device coupled to the host computer and capable of directing a specific file; and the AutoRun program is directed by the AutoRun configuration file, wherein the step (4-3) comprises: the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value; executing the AutoRun program in the semiconductor storage device to search for the specific file, copying the AutoRun program in the semiconductor storage device and the specific file to be executed to a host disk of

the host computer; and the copy of the AutoRun program in the host disk of the host computer calling and executing the copy of the specific file.

Chang generally describes an integrated circuit memory device with incorporated AutoRun functionality. Chang does not anticipate Claims 1 and 11 of the present application because Chang does not teach or suggest the steps of "the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value" and "copying the AutoRun program and the specific file to be executed to a host disk of the host computer" as recited in Claims 1 and 11.

The Examiner alleges that Chang inherently provides timing because the AutoRun executables provide timing for re-enumerating themselves when they have run their course, and cites Step 360 of Figure 3 of Chang as support. Applicants respectfully disagree.

First of all, the fact that the AutoRun executables re-enumerate themselves at the end of the AutoRun executables does not necessarily require a timing program and cannot be interpreted as inherently having a timing program. The execution of any computer program would take time. But it does not mean that every computer program inherently has a timing program.

Moreover, even if we assume, *arguendo*, that the AutoRun executables of Chang inherently possess a timing program, the timing program would be an inseparable part of the AutoRun executables because the timing is execution-dependent, *i.e.*, it is tied to the actual execution time of the AutoRun executables. For example, if it takes 20 seconds to run the AutoRun executable on computer A, the timing would be 20 seconds. If it takes 30 seconds to

run the AutoRun executable on computer B, the timing would then be 30 seconds, so on and so forth.

In contrast, the timing program recited in present Claims 1 and 11 is independent of the AutoRun program. As shown in Figure 5 and discussed in paragraphs [0075]-[0082] of the present application, the timing program is designed to send out a reset command in cases where the AutoRun program fails to send out a reset command (see, *e.g.*, paragraphs [0075]-[0076]). Accordingly, the predetermined timing value of the timing program is not less than the time required from the operation system accessing the AutoRun configuration file to the copy of the specific file being executed (see, *e.g.*, paragraph [0081]). In other words, the timing program is set with a predetermined timing value that is based on the estimated execution time of the AutoRun configuration file, but is independent of the actual execution time of the AutoRun configuration file. As noted in the present application, the timing program can either be used with the method for sending out the reset command by the AutoRun program (*i.e.*, as a back up of the execution-dependent timing), or be employed alone (see, *e.g.* paragraph [0082]).

In addition, with the feature "**copying the AutoRun program and the specific file to be executed to a host disk of the host computer**" as defined, it can avoid a sudden break of the execution or a blue-screen phenomenon, as mentioned in Paragraph 0067 of the Specification.

Chang does not teach or suggest anything about such a timing program and the step of copying. Therefore, Claims 1 and 11 are patentable over Chang.

Claims 2-7, 12-15 and 18-20 are patentable over Chang because they depend from one of Claims 1 and 11, and recite additional patentable subject matter. For example, Chang fails to teach or suggest the steps of "the copy of the AutoRun program sending out a reset command to the semiconductor storage device; and if the AutoRun program cannot successfully send out the

reset command, the timing program sending out a reset command to the semiconductor storage device when time reaches the predetermined timing value," as recited in Claim 13.

In view of the foregoing, Applicants respectfully submit that the grounds for this rejection have been obviated and withdrawal of the 35 U.S.C. §102 rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 9, 10, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang for the reasons set forth on pages 12-15 of the Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 9, 10, 16 and 17 depend from Claims 1 and 11. As discussed above, Chang generally describes an integrated circuit memory device with incorporated AutoRun functionality. Nonetheless, Chang neither mentions the step of "the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value" nor teaches "**copying the AutoRun program and the specific file to be executed to a host disk of the host computer**" as recited in Claims 1 and 11.

Therefore, Claims 1 and 11 are not obvious over Chang because Chang fails to teach or suggest every claimed limitation.

Furthermore, Chang fails to disclose the step of "copying the AutoRun program and the specific file to be executed to a host disk of the host computer." Consequently, the unexpectedly superior effect of the claimed invention render them particularly well suited for avoiding a sudden break of the execution or a blue-screen phenomenon, as described in paragraph 0067 of the Specification. One skilled in the art would not be able to use the present Claims 1 and 11 based on Chang without undue experimentation.

Claims 9, 10, 16 and 17 are patentable over Chang because they depend from one of Claims 1 and 11, and recite additional patentable subject matter.

In view of the foregoing, the grounds for this rejection have been obviated and withdrawal of the 35 U.S.C. §103 rejection is respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to contact Ping Wang (Reg. No. 48,328) at 202.842.0217.

Respectfully submitted,

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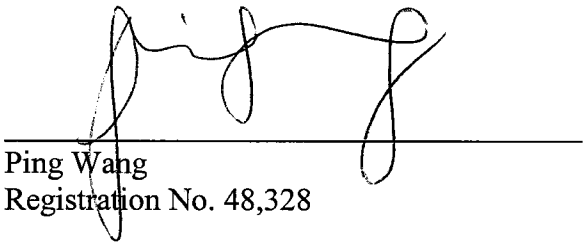

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